

Applicants: Cornelia J. Forster et al.
Application No.: 10/632,340

RECEIVED
CENTRAL FAX CENTER
JAN 25 2007

REMARKS

Claim Amendments

Applicants have canceled claim 15.

None of these amendments adds new matter.

The Official Action

35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 15 under 35 U.S.C. §112, first paragraph as lacking enablement. The Examiner contends that the specification, "while being enabling for a method of inhibiting GSK-3 activity in a standard biological assay, does not reasonably provide enablement for a method of inhibiting GSK-3 activity in a biological sample generally." Applicants respectfully disagree. Nevertheless, solely to expedite prosecution, applicants have canceled claim 15.

Accordingly, applicants request that the Examiner withdraw the 112, first paragraph rejection.

The §101 Rejection

The Examiner has rejected the claimed invention under 35 U.S.C. §101 as lacking utility. The Examiner contends that "the method of inhibiting GSK-3 kinase lacks utility to the extent it is limited to inhibition of GSK-3 kinase in biological samples." Applicants traverse.

However, solely to expedite prosecution, applicants have canceled claim 15. Accordingly, applicants request that the Examiner withdraw the 35 U.S.C. §101 rejection.

The Obviousness-Type Double Patenting Rejection

The Examiner has rejected claims 1-15, 18, and 23 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of United States Patent 6,696,452 (hereafter "the '452 patent"). Applicants traverse.

RECEIVED
CENTRAL FAX CENTER

JAN 25 2007

Applicants: Cornelia J. Forster et al.
Application No.: 10/632,340


Applicants respectfully submit that the Examiner has not established a *prime facie* case of obviousness for at least the following reasons. The '452 patent does not teach or suggest the particular genus recited in the amended claims. Specifically, the '452 patent does not suggest the desirability of the combination of a pyrimidine ring, a single aliphatic substituent (Ry) on the pyrimidine ring, a 2-trifluoromethylphenyl substituent at the 2-position of the pyrimidine, and the amino-linked pyrazolopyridine substituent at the 4-position of the pyrimidine. A person of skill in the art would not have been motivated to combine these elements to arrive at the compounds of the present application.

Accordingly, applicants request that the Examiner withdraw this double patenting rejection.

CONCLUSION

Applicants request that the Examiner enter the above amendments, consider the accompanying remarks, and allow the claims to pass to issue. If the Examiner believes that a telephone call would expedite prosecution, the Examiner is invited to contact the undersigned at any time.

Respectfully submitted,


Jennifer G. Che (Reg. No. 58,035)
Agent for Applicants
Lisa A. Dixon (Reg. No. 40,995)
Attorney for Applicants
Vertex Pharmaceuticals Incorporated
130 Waverly Street
Cambridge, Massachusetts 02139
Tel: (617) 444-6525
Fax: (617) 444-6483